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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,524	03/29/2001	Hua Chen	SOM920000010US1	5544
58776 7590 04/09/2007 RYAN, MASON & LEWIS, LLP 90 FOREST AVENUE LOCUST VALLEY, NY 11560			EXAMINER KANG, INSUN	
			ART UNIT 2193	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/09/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/727,524

Applicant(s)

CHEN ET AL.

Examiner

Insun Kang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-19 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-19, and 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the RCE amendment filed 9/26/2006.
2. As per applicant's request, claims 1-14, 16-19, and 21-25 have been amended and claims 15, 20, and 28 have been canceled. Claims 1-14, 16-19, and 21-27 are pending in the application.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 14, 16-19, and 21-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 14, 16, and 17 are non-statutory because they are directed to a system that does not have physical structural elements and the system comprises only instructions that are disembodied arrangements so as to be called a "computer program" or compilation of facts, information, or data *per se*, without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer ("acts") or tangible computer readable medium (excluding a communication/transmission medium such as a signal, carrier wave etc) so as to enable the computer to perform the claimed specification/contract. With no other structure in the independent claims to rely on, the alleged "system" of the claims turns out to be non-statutory for being a computer program *per se*. Thus the claims represent non-functional descriptive material that is not capable of producing a useful

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result, and hence represent only abstract ideas. Therefore, the claims are non-statutory.

Claims 18, 19, and 21-27 are non-statutory because they are directed to a "program medium" without recitation of a computer or a computer-readable medium embodying the program code. The claims merely recite a "program medium" that can be a mere program. Such a program does not create any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer ("acts") or computer readable medium so as to enable the computer to perform the claimed steps in the program code. Thus the claims represent non-functional descriptive material that is not capable of producing a useful result, and hence represent only abstract ideas.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5, 7, 8, 10, 11, 13, 14, 16-19, 22, 24, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibbon (US Patent 6,473,778) in view of Hui (US Patent 6,654,030).

Per claim 1:

Gibbon discloses:

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-combining a plurality of diverse rich media content into a single multimedia content file for use as a first input to an authoring tool (i.e. col. 11 lines 63-67; col. 12 lines 1-6; col. 13 lines 53-col. 14 line 7).

Gibbon discloses creating a text-based specification for use as a second input to the authoring tool(i.e. col. 3 lines 1-28; col. 13 lines 53-col. 14 line 7) but does not explicitly teach an extensible markup language (XML) based textual specification. However, Hui teaches a XML-based media description file was known in the pertinent art, at the time applicant's invention was made to easily understand, modify a media file, and for extensibility (i.e. col. 2 line 59-col. 3 line 30). It would have been obvious for one having ordinary skill in the art to modify Gibbon's disclosed system to incorporate the teachings of Hui by using the XML-based format instead of using the HTML representation. The modification would be obvious because one having ordinary skill in the art would be motivated to allow users to easily understand and edit media contents (i.e. col. 2 line 59-col. 3 line 30).

Hui further discloses: the XML-based textual specification comprises a user-specified vocabulary that defines one or more of the plurality of diverse rich media content and relationships between two or more of the plurality of diverse rich media content (i.e. col. 2 line 59-col. 3 line 30).

Gibbon in view of Hui further discloses combining the single multimedia content file and the XML-based textual specification in accordance with the user-specified vocabulary and using the authoring tool to create a composed multimedia content file for execution on a multimedia player (i.e. col. 13 lines 53-62).

Per claim 2:

The rejection of claim 1 is incorporated, and further, Gibbon teaches:

-d) editing the XML-based textual specification by a user using a text editor (i.e. col. 13 lines 53-62).

Per claim 3:

The rejection of claim 1 is incorporated, and further, Hui teaches:

e) using an XML program to create the XML-based textual specification (i.e. col. 2 line 59-col. 3 line 30).

Per claim 5:

The rejection of claim 1 is incorporated, and further, Hui teaches:

-transmitting the plurality of diverse rich media content as a streaming digital file (i.e. col. 5 lines 35-40).

Per claim 7:

The rejection of claim 1 is incorporated, and further, Gibbon teaches:

- storing the composed multimedia content file and the XML-based textual specification for access by one or more content creators (i.e. Fig 9).

Per claim 8:

The rejection of claim 1 is incorporated, and further, Hui teaches:

- downloading the composed multimedia content file for display to a user in an application (i.e. Fig 6).

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Per claim 10:

The rejection of claim 5 is incorporated, and further, Hui teaches:

- generating the streaming digital file as a binary file using a HotMedia format (i.e. col. 5 lines 35-40).

Per claim 11:

Gibbon discloses:

- a) a processor for receiving a plurality of diverse rich media (i.e. Fig 9);
- b) means for assembling the plurality of diverse rich media as a combined multimedia vehicle repository (MVR) file (i.e. Fig 9).

Gibbon does not explicitly teach an XML-based textual specification comprising a user-specified vocabulary that defines one or more of the plurality of diverse rich media content and relationships between two or more of the plurality of diverse rich media. However, Hui teaches an XML-based media description was known in the pertinent art, at the time applicant's invention was made to easily understand, modify a media file, and for extensibility (i.e. col. 2 line 59-col. 3 line 30). It would have been obvious for one having ordinary skill in the art to modify Gibbon's disclosed system to incorporate the teachings of Hui by using the XML-based format instead of using the HTML representation. The modification would be obvious because one having ordinary skill in the art would be motivated to allow users to easily understand and edit media contents (i.e. col. 2 line 59-col. 3 line 30).

Gibbon in view of Hui further discloses combining the MVR file and the XML-based textual specification in accordance with the user-specified vocabulary to create an edited MVR file for execution on a multimedia player (i.e. col. 13 lines 53-62).

Per claim 13:

The rejection of claim 11 is incorporated, and further, Hui teaches:

-an XML program running in the processor for translating descriptive text in combining the MVR file and the XML-based textual specification (i.e. col. 2 line 59-col. 3 line 30).

Per claim 14, it is the system version of claim 11, respectively, and is rejected for the same reasons set forth in connection with the rejection of claim 11 above.

Per claim 16:

The rejection of claim 14 is incorporated, and further, Hui teaches:

d) means for modifying the XML-based textual specification to create a new MVR-XML based file(i.e. col. 2 line 59-col. 3 line 30).

Per claim 17:

The rejection of claim 14 is incorporated, and further, Gibbon and Hui teaches:

-modifying the XML-based textual specification using a standard text-editing tool(i.e. Gibbon, col. 13 lines 53-62; Hui, i.e. col. 2 line 59-col. 3 line 30)..

Per claims 18, 19, 22, 24, 25, and 27, they are the program medium versions of claims 1, 3, 5, 7, 8, and 10 respectively, and are rejected for the same reasons set forth in connection with the rejection of claims 1, 3, 5, 7, 8, and 10 above.

7. Claims 4, 12, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibbon (US Patent 6,473,778), in view of Hui (US Patent 6,654,030), and further in view of Martens (US Patent 4,570,221).

In regard to claim 4, incorporating the rejection of claim 1 above:

"...executing a batch processing program to combine the single multimedia content file and the XML-based textual specification. "

Gibbon teaches the combining of the XML-based textual specification and a rich media content file, but neither Gibbon nor Hui teaches executing a batch processing. However, Martens teaches the combining of files executing a batch process (column 1, lines 25 - 28). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine two files, for example a descriptive file and a rich media content file as taught by Gibbon, and incorporate the teaching of Martens, because performing the combining with a batch process frees the user from the execution details and also enables the process to run of-line as taught by Martens (column 1, lines 25 - 28).

Per claim 12, it is the apparatus version of claim 4, respectively, and is rejected for the same reasons set forth in connection with the rejection of claim 4 above.

Per claim 21, it is the program medium version of claim 4, respectively, and is rejected for the same reasons set forth in connection with the rejection of claim 4 above.

8. Claims 6 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibbon (US Patent 6,473,778) in view of Hui (US Patent 6,654,030), and further in view of (Mills, U.S. Patent 6,397,219).

In regard to claim 6, incorporating the rejection of claim 1 above:

"... using a graphical authoring tool to edit the plurality of diverse rich media content; "

Gibbon teaches collecting rich media content and combining with a descriptive file with an authoring tool, but neither Gibbon nor Hui teaches a graphical authoring tool. However, Mills discloses a graphical authoring tool (column 15, line 60 to column 16, line 16). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the authoring tool as taught by Gibbon which combines a descriptive file and a rich media content, with the graphical authoring feature as disclosed by Mills, because this modification provides a means for the authoring tool of Gibbon easily access and efficiently edit Web pages, as taught by Mills (column 15, lines 60- 67). Gibbon further discloses creating a description file of the graphically edited rich media content (a description file as input; column 13, line 53 to column 14, line 7).

In regard to claim 23, incorporating the rejection of claim 18 above:

Claim 23 (program code medium) is rejected for the same reasons put forth in the rejection of claim 6 (the corresponding method).

9. Claims 9 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibbon (US Patent 6,473,778) in view of Hui (US Patent 6,654,030, and further in view of Ohsuga et al.(U.S. Patent 6,317,151) hereinafter referred to as Ohsuga.

In regard to claim 9, incorporating the rejection of claim 5:

"...generating the streaming digital file as a sequence of frames."

Gibbon combined with Hui teaches collecting rich media content and combining with a descriptive file having a user-defined vocabulary defining content and relationships, modified by Murphy teaching the transmission of a streaming digital file containing rich media content (video/audio feed). Although Murphy references the digital stream as a series of packets, neither reference teaches that the generation of the streaming digital file specifically as a sequence of frames. However, Ohsuga teaches streaming video to a digital file as a sequence of frames (column 1, lines 36 - 43). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine the teachings of Gibbon and Murphy to obtain a means to merge a descriptive file with a rich media content and incorporating the generation of the rich media content as a streaming digital file in a sequence of frames as taught by Ohsuga because the digital frame allows the user to capture natural images and then edit them a reproducible digital format (see column 1, lines 36 - 42) that could be used as rich media content as taught by Gibbon.

In regard to claim 26, incorporating the rejection of claim 22:

Claim 26 (program code medium) is rejected for the same reasons put forth in the

rejection of claim 9 (the corresponding method).

Response to Arguments

10. Applicant's arguments filed 9/26/2006 have been fully considered but they are not persuasive.

The applicant states that: 1) Hui fails to remedy the deficiencies of Gibbon because Hui fails to disclose "anything regarding a user specified vocabulary (page 11)." 2) Gibbon fails to disclose the combining of a plurality of diverse rich media content into a single multimedia content file (page 10).

In response to the statement 1) above: Hui specifically discloses a XML-based textual specification (i.e. col. 2 line 59-col. 3 line 30) and one having ordinary skill in the art would know that using an XML allows a user to define his/her own tags.

In response to the statement 2) above: Gibbon discloses that "individual video frames are extracted from the video portion of the television program ...to produce a hypermedia document (col. 11, lines 63-67; col. 12 lines 1-6)." The plural video frames are extracted from the single program.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Insun Kang whose telephone number is 571-272-3724. The examiner can normally be reached on M-R 6:30-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MENG AI AN can be reached on 571-272-3756. The fax phone number for

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the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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